UNITED STATES PATENT AND TRADEMARK OFFICE

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FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

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YENKE, BRIAN P

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SHUNTARO ARATANI,
YOSHIKAZU SHIBAMIYA, SHIGEKI MORI,
KATSUHIRO MIYAMOTO, and TOMOYUKI OHNO

_____

Appeal 2009-003776
Application 09/987,569
Technology Center 2600

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Decided: November 16, 2009

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Before ROBERT E. NAPPI, MARC S. HOFF, and
THOMAS S. HAHN, *Administrative Patent Judges.*

HAHN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants invoke our review under 35 U.S.C. § 134(a) from the

Examiner's final rejection of claims 46-61. We have jurisdiction under 35

U.S.C. § 6(b). An oral hearing was held on September 22, 2009. We

affirm-in-part.

STATEMENT OF THE CASE

Appellants claim an apparatus and method invention for a television receiver with an interconnected printer. The television receiver extracts document data from received broadcast signals, and the document data includes printer status display information. A process for acquiring printer status information is executed, and the acquired printer status information is displayed.[1] Independent claim 46, with key disputed limitations emphasized, is illustrative:

> 46. A television signal receiving apparatus (a) connected to a printer in a manner to allow the apparatus to communicate with the printer and (b) capable of sending to the printer data obtained from contents data, the contents data having been sent multiplexed in broadcast by a broadcasting apparatus and received by said television signal receiving apparatus, said television signal receiving apparatus comprising:
>
> *extracting means for extracting document data* which is described in a markup language and included in the contents data, the document data including *(a) a script for acquiring status information of the printer and (b) a plurality of status display information*;
>
> generating means for generating display image data which can be displayed on a display unit, using the document data extracted by said extracting means; and
>
> *executing means for executing a process for acquiring the status information of the printer* as well as a process for, in accordance with the acquired status information, identifying status display information indicating a status of the printer from the plurality of status display information included in the document data, said executing means comprising means for executing the script,

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[1] *See generally* Spec. ¶¶ [0053]; [0065]-[0070]; [0081]-[0085]; Figs. 4-7 and 9-11.

wherein said *generating means reflects, in the display image data, the status display information identified by said executing means.*

The Examiner relies on the following as evidence in support of the rejections:[2]

Valdez	US 6,426,778 B1	July 30, 2002
Ihara	US 2003/0164976	Sep. 4, 2003

The Examiner rejected claims 46-61 under 35 U.S.C. § 103(a) as unpatentable over Ihara and Valdez (Ans. 3-5).

Rather than repeat the arguments of Appellants or of the Examiner, we refer to the Brief (filed May 13, 2008), the Answer (mailed June 26, 2008), and the Reply Brief (filed Aug. 26, 2008) for their respective details. Only arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but are not made are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Arguments

Appellants' assert that independent claims 46 and 51 are patentable, because

(1) neither cited reference suggests that printer status display information text data is included data in broadcast signals and is used as recited in disputed limitations; and

(2) the Examiner relies on Appellants' Specification for what is not admitted as prior art, and also relies on Appellants' disclosed invention embodiments for prior art admissions.

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[2] Effective filing dates for these documents precede Appellants' earliest effective filing date and are not at issue.

(App. Br. 11). Turning to dependent claims, Appellants assert *inter alia* that the Examiner fails to provide bases for finding a timer as recited in claims 48, 49, 53, and 54, or coordinating printer power control with display of printer status information as recited in claims 50 and 55 (App. Br. 18, 19).

ISSUES

Under § 103(a), have Appellants shown the Examiner erred in rejecting claims 46 and 51 by finding that (1) Appellants have admitted as prior art that printer status display information is included in broadcast signals; and (2) Ihara and Valdez, in combination with asserted prior art admissions, teach or suggest use of printer status display information, included in broadcast signals, to display printer status?

Under § 103(a), have Appellants shown the Examiner erred in finding the cited references as teaching or suggesting a timer as recited in rejected claims 48, 49, 53, and 54, or coordinating printer power control with display of printer status information as recited in rejected claims 50 and 55?

FINDINGS OF FACT

A preponderance of the evidence supports the following Findings of Fact (FF):

Present Application

1. Appellants' Specification includes multiple acknowledgments that when the application was filed, television broadcast signals were being transmitted using the ISO/IEC Standard 13818-6, and that these

broadcast signals included not only picture information with video and audio data, but also text information, script information, display layout information, print layout information, and that the "text information is described in the XML (eXtensible Markup Language) defined in the World Wide Web Consortium (W3C)" (Spec. ¶¶ [0009], [0057]).

2. It is further acknowledged in the Specification that it had been "recognized that [for] convenience . . . information delivered by data broadcasting service is displayed on a television screen and printed out for [a] permanent record" (Spec. ¶ [0010]).

Ihara

3. Ihara discloses a method for operating a system that includes a television device with a printer device connected over an IEEE 1394 standard interface so that the printer device is controlled to print images (Ihara, ¶¶ [0002], [0069]).

4. The Ihara disclosed system includes equipment, e.g., a demodulator 11 and descrambler 12, for processing received data signals, and an actuating input unit 21 connected to a central processing unit 23 to actuate printing instruction signals for specifying image printing (Ihara, ¶¶ [0072], [0096]-[0098]).

5. Ihara further discloses that an included system set top box 3 can be controlled to communicate control parameters to the printer 5, and that the set top box 3 receives information from the printer 5 as to operation mode parameters (Ihara, ¶¶ [0103], [0112]-[0114], and [0171]).

6. An Ihara display controller is disclosed for generating printer status information in addition to picture images (Ihara, ¶ [0095]).

Valdez

7. Valdez discloses a method and computer based systems, which include monitors, graphic displays or printing devices, to display interactive indicia, such as markup language elements, in received motion video (Valdez, col. 1, ll. 6-8; col. 5, ll. 5-10).

8. According to Valdez, it was known to use a WebTV Internet browser to display broadcast signal received markup language data with video data, and process interactive user inputs (Valdez, col. 3, ll. 14-39).

PRINCIPLES OF LAW

An Examiner, in rejecting claims under 35 U.S.C. § 103, must establish a factual basis to support a legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The required factual determinations are set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to required factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art). Furthermore,

> "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'. . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."

KSR Int'l v. Teleflex, Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

All claim limitations must be considered when determining patentability. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). However, patentable weight need not be given to nonfunctional descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); *Gulack*, 703 F.2d at 1385.

ANALYSIS

Claims 46 and 51

Appellants collectively argue patentability for independent claims 46 and 51, and, accordingly, we select claim 46 as representative. *See* 37 C.F.R. § 41. 37(c)(1)(vii). Based on the record we are not persuaded the Examiner erred in rejecting representative claim 46 under § 103.

Appellants' arguments are directed to claim 46 disputed limitations, *see supra* (App. Br. 13-17; Reply Br. 7-12). Appellants assert that (1) neither cited reference suggests that printer status display information text data is included in broadcast signals or is used as recited in disputed limitations; and (2) the Examiner improperly relies on Appellants' Specification for what is not admitted as prior art, and also relies on disclosed invention embodiments as prior art admissions (App. Br. 11).

The Examiner and we find that Ihara discloses a system that includes a television device with a printer device connected over an IEEE 1394 standard interface so that the printer device is controlled to print images

(Ans. 3; FF 3). Additionally, the Examiner and we find that the Ihara system discloses displaying printer status information (Ans. 3; FF 6).

The Examiner acknowledges that Ihara does not teach or suggest "receiving markup language in the received broadcast," which the Examiner indicates "is notoriously well known in the art" (Ans. 3). As support, the Examiner cites Valdez for disclosing systems that receive TV broadcast signals, which include markup language, and control picture displays in response to the received picture and markup data (*id.*). We also find Valdez disclosing computer based systems that include monitors, graphic displays or printing devices, to display broadcast signal received interactive indicia, such as markup language elements (FF 7, 8).

The Examiner turns to Appellants' Specification for further support, and finds disclosures acknowledging that inclusion of document data information in broadcast signals was known. According to the Examiner, Appellants' "disclosure states that control/script data is received from the broadcast signal – thus a receiver/decoder on the user's end needs only to receive such signal and carry out the appropriate instructions/script" (Ans. 4). We also find Appellants' disclosing that ISO/IEC Standard 13818-6 had been used for transmitting television broadcast signals with included text, script, display layout, and print layout information data (FF 1). Further we find Appellants' Specification disclosing that it had been "recognized that [for] convenience . . . information delivered by data broadcasting service is displayed on a television screen and printed out for [a] permanent record" (FF 2). These disclosures from Appellants' Specification are referenced to prior art, e.g., an identified industry standard, and are made without qualification as to being distinguished from prior art. Thus, Appellants'

Specification and also Valdez disclose prior art receiving and using, i.e., displaying of received information data (FF 2, 8). Without contradictory or explanatory submitted evidence, Appellants attempt to dismiss these disclosures that are of record with attorney arguments. Arguments made by counsel, however, do not take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965); *see also In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997). Such argumentative statements, without corroborating evidence, fall short of rebutting the Examiner's prima facie case of obviousness articulated in the rejection – a position that we find reasonable. Accordingly, Appellants have simply not persuasively rebutted the Examiner's positions that we find to be reasonable.

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of representative claim 46. Therefore, we will sustain the Examiner's rejection of that claim, and also claim 51.

Claims 47 and 52

Both of claims 47 and 52, which respectively depend directly from base independent claims 46 and 51, recite descriptive material for "contents data" as "includ[ing] style format data defining a display layout of the display image data and the style format data defines a status display area for displaying the status display information in the display image data."

Appellants argue for these claims by paraphrasing the Examiner's position. Specifically, Appellants assert that "[t]he Examiner takes the position that because IEEE 1394 allows for communication between devices, all such communications would be obvious in view of the standard itself" (App. Br. 17). Appellants acknowledge that "dependent Claims 47 and 52 recite that contents data sent multiplexed in broadcast by a

broadcasting apparatus include specific data, namely, style format data which defines both a display layout and a status display area" (App. Br. 18). Appellants, however, are silent as to any functional or structural limitation being recited in claims 47 and 52 that might distinguish over the prior art.

We consequently find the "style format data," which is recited with explaining definitions, as being merely descriptive material that lacks any new and unobvious functional relationship to the base independent claim's recited "multiplexed" broadcast. Appellants, by reciting data descriptions without more limitations, fail to limit the claimed subject matter either functionally or structurally. Therefore, this further described data constitute non-functional descriptive material, and by not limiting the claimed subject matter either functionally or structurally, is without patentable weight and does not patentably distinguish over prior art that otherwise renders the claims unpatentable.[3]

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of dependent claims 47 and 52. Therefore, we will sustain the Examiner's rejection of these claims.

Claims 48 and 53

Both of claims 48 and 53, which respectively depend directly from base independent claims 46 and 51, recite that the claim 46 "executing means has" or the claim 51 "executing step uses" a "timer for executing the script at a predetermined period."

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[3] *See Ngai*, 367 F.3d at 1338; *see also Ex Parte Nehls*, 88 USPQ2d 1883, 1887-89 (BPAI 2008) (precedential) (discussing cases pertaining to non-functional descriptive material).

The Examiner does not separately address these or other dependent claims, but collectively indicates that "Ihara discloses a system which customizes the print function based upon received picture information, which includes display layout/style format (para 97, 112-114, 121-126 and 154)" (Ans. 5). The Examiner further indicates that the taught IEEE 1394 interface with a printer permits previously known functions such as receiving and transmitting printer status information to be displayed on a monitor (*id.*). Appellants argue that "the Examiner provides no clear rationale for why such a protocol [i.e. IEEE 1394] would obviate the recited features . . . ." (App. Br. 18).

Based on the record, we are unable to find that the Examiner has provided a factual basis, reasoning, or rationale for finding the prior art as teaching or suggesting any timer, much less a timer as is recited in claims 48 and 53. Accordingly, Appellants have persuaded us of error in the Examiner's rejection of claims 48 and 53, and we will not sustain the Examiner's rejection of these claims.

Claims 49 and 54

Both of claims 49 and 54, which respectively depend from claims 48 and 53, recite that printer status information is acquired "at a predetermined period by starting an operation of the timer after the content data for printing is sent to the printer."

As noted *supra*, the Examiner collectively addresses the dependent claims without citing prior art as teaching or suggesting a timer, or, consequently, any associated operation (*see generally* Ans. 5). Appellants argue that "the Examiner has provided no basis for arguing that such an operation is defined or suggested by the IEEE 1394 standard" (App. Br. 19).

Again, based on the record, we are unable to find that the Examiner has provided a factual basis, reasoning, or rationale for finding the prior art as teaching or suggesting any timer or associated operation as is recited in claims 49 and 54. Accordingly, Appellants have persuaded us of error in the Examiner's rejection of claims 49 and 54, and we will not sustain the Examiner's rejection of these claims.

Claims 50 and 55

Both of claims 50 and 55, which respectively depend directly from base independent claims 46 and 51, recite that the claim 46 "executing means" or the claim 51 "executing step includes a command to switch the power of the printer on after the status information of the printer is acquired."

As noted *supra*, the Examiner collectively addresses the dependent claims. The Examiner additionally has not cited prior art as teaching or suggesting switching printer power on after acquiring printer status information (*see generally* Ans. 5). Appellants argue that "there is no basis for assuming that a standard [i.e. IEEE 1394] for communication between devices suggests that, with respect to execution of a script sent in a television broadcast, there is provided a command to turn on a printer after status information is acquired" (App. Br. 19).

Based on the record, we are unable to find that the Examiner has provided a factual basis, reasoning, or rationale for finding the prior art as teaching or suggesting switching printer power on after acquiring printer status information as is recited in claims 50 and 55. Accordingly, Appellants have persuaded us of error in the Examiner's rejection of claims 50 and 55, and we will not sustain the Examiner's rejection of these claims.

Claim 56

Claim 56, which depends directly from base independent claim 46, recites that document data "comprises printing interface user data, used to provide a user interface describing to a user of the apparatus a printing function to be carried out." Appellants argue that inclusion "of data for providing a user interface describing a printing function is not suggested by the IEEE 1394 standard" (App. Br. 20).

We find the recited data intended for describing a printing function to a user to be merely descriptive material that lacks any new and unobvious functional relationship to the base independent claim 46 recited document data. Appellants by reciting inclusion of data in a television broadcast signal for describing "a printing function" without more limitations fail to limit this claimed subject matter either functionally or structurally. Therefore, this further described document data constitute non-functional descriptive material, and by not limiting the claimed subject matter either functionally or structurally, is without patentable weight and does not patentably distinguish over prior art that otherwise renders the claim unpatentable.[4]

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of dependent claim 56, and we will sustain the Examiner's rejection of the claim.

Claim 57

Claim 57, which depends directly from base independent claim 46, recites that document data "comprises print button text, and wherein said generating means further reflects in the display image data a print button

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[4] *See* n. 3.

image in accordance with the print button text." Appellants argue that "inclusion in a television broadcast of data for providing a print button image is not contemplated by the IEEE 1394 standard" (App. Br. 20).

We find this claim as setting forth a further functional limitation directed to the base independent claim 46 by reciting that "said generating means further reflects in the display image data a print button image in accordance with the print button text." The Examiner, however, does not separately address the dependent claims (*see generally* Ans. 5). Accordingly, based on the record, we are unable to find without speculation that the Examiner has provided a factual basis, reasoning, or rationale for finding the prior art as teaching or suggesting the further recited functional limitation. Therefore, Appellants have persuaded us of error in the Examiner's rejection of claim 57, and we will not sustain the Examiner's rejection.

Claim 58

Claim 58, which depends directly from base independent claim 46, recites that document data "comprises text informing a user of the apparatus that the printer is ready to print." Appellants argue that "inclusion in a television broadcast of data for providing text indicating that printer is ready to print is not suggested by the IEEE 1394 standard" (App. Br. 20).

We find the recited subject matter as being merely descriptive material that lacks any new and unobvious functional relationship to the base independent claim 46 recited document data. Appellants by reciting inclusion of data in a television broadcast signal for printer ready text without more limitations fail to limit this claimed subject matter either functionally or structurally. Therefore, this further described document data

constitute non-functional descriptive material, and by not limiting the claimed subject matter either functionally or structurally is without patentable weight and does not patentably distinguish over prior art that otherwise renders the claim unpatentable.[5]

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of dependent claim 58, and we will sustain the Examiner's rejection of the claim.

Claim 59

Claim 59, which depends directly from base independent claim 46, recites that document data "comprises text informing a user of the apparatus that the printer has completed printing." Appellants argue that "inclusion in a television broadcast of text for informing a user that printing is complete is not contemplated by the IEEE 1394 standard" (App. Br. 21).

We find the recited subject matter as being merely descriptive material that lacks any new and unobvious functional relationship to the base independent claim 46 recited document data. Appellants by reciting inclusion of data in a television broadcast signal for text to inform a user that printing is complete without more limitations fail to limit this claimed subject matter either functionally or structurally. Therefore, this further described document data constitute non-functional descriptive material, and by not limiting the claimed subject matter either functionally or structurally is without patentable weight and does not patentably distinguish over prior art that otherwise renders the claim unpatentable.[6]

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[5] *See* n. 3.
[6] *See* n. 3.

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of dependent claim 59, and we will sustain the Examiner's rejection of the claim.

Claim 60

Claim 60, which depends directly from base independent claim 46, recites that document data "comprises text informing a user of the apparatus that the printer is not compatible with a requested paper size." Appellants argue that "inclusion in a television broadcast of text for indicating that a printer is not compatible with the request[ed] paper size user is not contemplated by the IEEE 1394 standard" (App. Br. 21).

We find the recited subject matter as being merely descriptive material that lacks any new and unobvious functional relationship to the base independent claim 46 recited document data. Appellants by reciting inclusion of data in a television broadcast signal for text indicating that a printer is not compatible with a requested paper size without more limitations fail to limit this claimed subject matter either functionally or structurally. Therefore, this further described document data constitute non-functional descriptive material, and by not limiting the claimed subject matter either functionally or structurally is without patentable weight and does not patentably distinguish over prior art that otherwise renders the claim unpatentable.[7]

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of dependent claim 60, and we will sustain the Examiner's rejection of the claim.

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[7] *See* n. 3.

Claim 61

Claim 61, which depends directly from base independent claim 46, recites that document data "comprises text informing a user of the apparatus that the printer has stopped printing because of an error." Appellants argue that "inclusion in a television broadcast of text indicating that a printer has stopped printing is not contemplated by the IEEE 1394 standard" (App. Br. 21).

We find the recited subject matter as being merely descriptive material that lacks any new and unobvious functional relationship to the base independent claim 46 recited document data. Appellants by reciting inclusion of data in a television broadcast signal of text to indicate that printing has stopped because of an error without more limitations fail to limit this claimed subject matter either functionally or structurally. Therefore, this further described document data constitute non-functional descriptive material, and by not limiting the claimed subject matter either functionally or structurally is without patentable weight and does not patentably distinguish over prior art that otherwise renders the claim unpatentable.[8]

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of dependent claim 61, and we will sustain the Examiner's rejection of the claim.

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[8] *See* n. 3.

CONCLUSIONS

Appellants have not shown that the Examiner erred in rejecting claims 46, 47, 51, 52, 56, and 58-61 under § 103(a), and the rejection is affirmed.

Appellants, however, have shown that the Examiner erred in rejecting claims 48-50, 53-55, and 57, and the rejection is not affirmed.

ORDER

The Examiner's decision rejecting claims 46-61 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800